

REMARKS

The applicant thanks the examiner for conducting a telephone interview with the applicant's representatives David L. Feigenbaum and Misha K. Hill on Oct 10, 2006. The examiner and the representatives discussed the claim language and merits of claims 23-25 and 73 and agreed that the applicants would withdraw claims 14-17, 72 and 74-76 and submit detailed arguments in support of the remaining claims.

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

**Claims 23-25 and 73 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

The amended claim 23 and new claim 73 recite the limitation “the communication medium being selected based at least in part on whether the second device is included on the list, and on the fact that the second device is being used by the second identifier user”. However, the selection of a communication medium based on both condition was not described as shown in the disclosure, page 5, line 14 through page 6, line 4.

Depend claims 24-25 are rejected for the same reason.

\*\*\*

Claims 23-25 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Irvin (U.S. Patent 6,658,264) in view of Jonsson et al. (US 2003/0036350).  
Regarding claim 23, Irvin teaches a method comprising: maintaining a list of short-range wireless devices within range of a first short-range wireless device (col. 8, 59-64, double entry phonebook, walkie-talkie access number, see also walkie-talkie or Bluetooth transceiver in col. 9, lines 2-5); transmitting a message using a communication medium from an identified user of the first device to a second wireless device being used by a second identifier (col. 8, 64-66, place the call), the communication medium being selected based at least in part on whether the second device is included on the list, and inherently on the fact that the second device is being used by the second identifier user, the selection being transparent to the user of the first device (col. 8, 66 through col. 9, 4, see if the cellular number can be associated with a walkie-talkie access number). Irvin does not teach the inherency in the Bluetooth communication system that when in range or to be known within range the Bluetooth devices invoke a service discovery protocol (SDP) so that the devices can know each other when in range. Jonsson teaches that when in range or to be known within range the Bluetooth devices invoke a service discovery protocol (SDP) so that the devices can have the list of desired neighbor devices (see [0003], [0026]). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jonsson to the system of Irvin so that only devices belong to a desired class can be selected.

\*\*\*

Applicant further contends that neither Irvin nor Jonsson describes choosing a communication medium based on “the fact that the second identified user is using the second device”.

In response, it is unsure that this limitation is supported by the original description. Assuming it is so, if the second identified user is not using the second device there will be no call to the second party using either walkie-talkie or cellular network as one can see in column 8, line 59 through column 9, line 5 of Irvin.

The limitation that the communication medium is selected based “on the fact that the second device **is being used** by the second identified user” is supported by the specification, which states at page 28, lines 20-24, that when a message is sent to a particular user from the server through the links, the message is sent to all of the user’s devices “**on which he is logged on**” (emphasis added). In that example, a server that is facilitating the communication between users sends messages only to devices on which the receiving user is, as a matter of fact, logged on, that is, devices which he is using.

This limitation distinguishes claim 23 from Irvin and Jonsson. In claim 23, “the communication medium [is] **selected**” based on whether a device is within range and whether the intended recipient is using it. Irvin selects the communication medium based other factors. Irvin states that “the double entry phonebook is consulted to see if the cellular number **can be associated** with a walkie-talkie access number. If **the association** is positive, the cellular telephone **attempts to place the call** over the walkie-talkie rather than the cellular network” (col. 8, lines 62-66, emphasis added). Irvin also states that “the user can indicate which transceiver access number to try first with respect to each entity listed in the phone book when initiating a call by setting the user system preference” (col. 7, lines 16-21). That is, Irvin selects the walkie-talkie medium based on its identification in the double-entry phone book and the user’s preference to use that medium, not based on the fact that the second user is using the second device. There is no indication that Irvin’s device knows whether the second user is using the second device at all. As the examiner notes, if the user is not using the device, the call may not go through, but that is not what is claimed. Irvin may *transmit* a message (or fail to do so) based on whether a device is being used by the recipient, but it does not *select the communication medium* based on knowledge of that fact. Jonsson describes a system that includes a list of nearby devices (see, e.g., ¶ 0026), but it also does not describe selecting a

communication medium based on the fact that the receiving device is being used by the intended recipient.

**Regarding claim 73, the claims is interpreted and rejected for the same reason as set forth in claim 23.**

Claim 73 has been amended and is patentable for at least the same reasons as claim 23. Irvin does not describe and would not have made obvious "maintaining a list of short-range wireless devices that are known to be ... in use by identified users associated with the devices" and then using a short-range radio link "if a second device is included in the list," that is, using the short-range link only if the device is in use.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

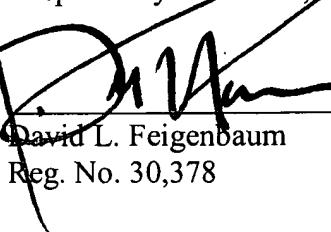
No fees are believed due at this time. Please apply any charges or credits to deposit account 06-1050, reference 12206-002001.

Date: 10/13/06

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906

21410980.doc

Respectfully submitted,

  
David L. Feigenbaum  
Reg. No. 30,378